

telephonic discussions he has conducted with applicant's undersigned representative on September 4 and December 2, 2002 regarding the subject application, the outstanding Office Action and the possibility of conducting a personal interview with the Examiner sometime in February 2003. During such discussions it was agreed that applicant's representative would be filing on December 2, 2002 a Request for CPA including a Request for a Three Month Suspension of Action in the application to permit time for the interview in February, and that applicant's representative would be further contacting the Examiner to indicate a specific date for the interview.

Upon entry of the present amendment the claims in the application are claims 14-16, 19, 20, 26, 27, 30-33 and 36-44, of which claims 14, 19 and 20 are independent, and of which claims 14-16, 19 and 36 have been withdrawn from consideration by the Examiner as being drawn to a non-elected invention. Newly added claim 44 is encompassed by the elected invention in this application.

Pursuant to the Examiner's request, enclosed herewith are copies of Japanese Patent Publications 4-41410 and 3-267171, together with an English language abstract for Publication 3-267171. Also enclosed is a copy of Reexamined US Patent B1 5,411,760 (Woodhall et al.), which was recently cited by the Examiner in parent application 08/398,881.

Further, it is noted that all of the priority Japanese Patent Applications have been examined and matured into patents based on the merits of the claimed invention. Copies of the Japanese Patents are enclosed herewith.

The Amendments

Claims 40 and 43 have been amended to more specifically define that the strippable paint is water soluble and to define the ambient temperature and humidity maintained during the stabilizing step, while new claim 44 depends from claim 20 and further defines partially and finally drying steps for the strippable paint coated on the automobile surface. The specification is amended to add a statement referring to the existence and status of parent application 08/398,881 pursuant to the

requirement set forth at item 2 of the Office Action.

Applicant respectfully submits that all of the above amendments are fully supported by the original disclosure, including the discussion at pages 13-15 of the specification, and that no new matter is introduced by the amendments.

Rejection Under 35 USC §112

The Examiner has rejected claim 43 under 35 USC §112, first and second paragraphs, as presented at items 3 and 5 of the Office Action. It is the Examiner's position that persons skilled in the art would not be enabled to make and use the invention of claim 43 because the disclosure does not teach what constitutes a "long time", and also that such language is indefinite for the same reason.

Applicant's Response

Upon careful consideration and in light of the amendment to claim 43, applicant respectfully traverses such rejections and submits that claim 43 complies with the requirements of 35 USC §112, first and second paragraphs, because the claim language would be clearly understood by persons skilled in the art in light of the full disclosure set forth in the specification (including use of the separate setting booth 5 shown in Fig. 1 and the discussion of the stabilizing step at page 14, lines 6-22 for a water soluble strippable paint), and similarly persons of ordinary skill in the art would understand how (be enabled) to stabilize the applied strippable paint as claimed and disclosed because this is a very straightforward operation (i.e., moving the painted vehicle into a setting booth at a temperature of 15-30°C and humidity of 50-80% for a sufficiently long time that the applied coating is stabilized prior to being dried in the pre-drying furnace 7).

Particularly, the stabilizing feature of the invention is disclosed (e.g., with reference to Fig. 1 and the discussion at pages 13- 14 of the specification) as encompassing a specific, substantive step occurring in the setting booth 5 when a painted vehicle is moved by a conveying

machine 10 between the application of strippable paint to a surface (step 6 carried out in application booth 4) and drying of the applied paint (steps 9 in furnaces 7, 8), and wherein the painted vehicle is allowed to set in the booth 5 (which has a maintained atmosphere) until the applied paint is stabilized. The example given involves moving a vehicle painted with a water soluble strippable paint into the separate setting booth 5 having an inner ambient maintained at a temperature of 15-30 °C and 50 -80% humidity and allowing the painted vehicle to stand a long time in the booth to cause the formed film to stabilize.

The presence of relative terms in claims is permitted under 35 USC § 112, second paragraph, as long as the specification provides some standard for interpreting the relative terms. In the present matter, the amended language of claim 43 including the relative language -- long time -- would be clearly understood by artisans from the context of the overall process for forming the protective film (the long stabilization time occurs in the setting booth 5 between the application step in which the strippable paint is sprayed or otherwise applied onto the vehicle's surface and the preliminary drying action in which the stabilized paint film is irradiated for 30-60 seconds with IR radiation having a wavelength of 2-4 μ m, with the vehicle being moved between the various booths and furnaces by the conveying machine 10), as well as from the simple setting nature of the stabilizing activity.

Further, applicant respectfully submits that based on the present disclosure and conventional understanding persons skilled in the art would certainly understand how a water soluble strippable paint, such as the Lapguard™ product of Kansai Paint Co., becomes stabilized after being applied to a vehicle's surface and then allowed to set for a long time under conditions as described, prior to being dried under the discussed drying conditions. Correspondingly, applicant also respectfully submits that persons skilled in the art would be enabled to make and use the claimed invention.

In this regard, the very simple nature of the stabilization step is indicative of the adequacy of the present disclosure for enabling skilled artisans to make and use the claimed feature. It has

long been held that the question of whether undue experimentation would be required for an artisan to practice the invention is not a merely quantitative issue, e.g., a great deal of experimentation may not be undue if the experimentation is merely routine. Similarly, it has been held that the level of skill in the art, the nature of the invention, predictability of the art, breadth of the claims, etc. are factors which are to be considered in determining enablement of a disclosure, and in the present matter such factors favor a finding of enablement.

Based on the foregoing, applicant respectfully submits that the rejections of claim 39 under 35 USC § 112, first and second paragraphs, are overcome and accordingly it is respectfully requested that the rejections be reconsidered and withdrawn.

Art-Based Rejections

The Examiner has maintained the art-based rejections of claims 20, 26, 27, 30-33 and 37-42 under 35 USC §102(b) and/or §103(a) from the prior Office Action, as set forth at item 7 of the Office Action, while the Examiner has also indicated that he is not persuaded by the Declarations of Mr. Tojo and Mr. Kurota under 37 CFR §1.132 submitted with the prior Amendment-E because the subject matter of the Declarations would have been readily apparent to one of ordinary skill in the art, as set forth in item 8 of the present Office Action.

Applicant's Response

Again, applicant respectfully traverses the rejections for those reasons set forth in Amendment-E. Most notably:

- 1) none of the reference of record (including discussion of conventional practices in the present application and Swidler's discussion of disposable protective covers used to protect finished surfaces of fully manufactured vehicles when they are stored and transported) disclose or suggest the claimed advantageous method of using the strippable paint as a protective coating on paint finished surfaces during a step of assembling an engine and functional parts to a vehicle during its manufacture, functioning as a replacement for conventional re-usable anti-scratch covers which very labor-intensive to use, such that any hypothetical combination of the prior art

teachings based on the actual disclosures thereof would not achieve or make obvious the claimed invention;

2) persons of ordinary skill in the art would not consider it obvious to modify Swidler's simple method of air drying strippable paint to instead include a multiple stage drying as disclosed by Nelson relative to first class paint finishes because the full, fair disclosures of the references teach away from the proposed modification; and

3) none of the art/references of record disclose/suggest a stabilizing step for the strippable paint, in addition to the drying steps as claimed, nor would such step be an obvious matter of design choice in light of the references because none of the references teach a corresponding step.

Relative to the item 2), Swidler's disclosure focuses on use of the strippable paint as a *temporary* protection for paint finished surfaces and the like, wherein the strippable paint is simply applied and dried to the exterior of automobiles under ambient conditions and later simply removed with an aqueous solution after the automobiles have been transported to a given destination. Swidler indicates that important advantages of his invention are that it can be applied and removed "quickly, easily, cheaply and safely." Quite differently, Nelson's disclosed two stage method specifically pertains to formation of high gloss Class A surfaces "... having as high a quality of finish as possible" because this improves the marketability of the vehicle. On the other hand, Nelson distinguishes such Class A Surfaces from finishes on other surfaces of the vehicles, e.g., surfaces which are not readily visible to the end user, indicating that such other surfaces "... only require a finish sufficiently good to protect the vehicle's surface from the elements", and specifically indicates that his two stage drying method would not be used in relation to surfaces which are not Class A.

Given that Swidler's strippable paint coatings are not Class A Surfaces, but are only temporary protective films which are never seen by the persons purchasing the vehicles, persons skilled in the art would not consider it obvious to hypothetically modify Swidler's process to

involve two-stage drying of a coated strippable paint based on the teachings of Nelson because the references provide no motivation for such a modification, actually *teaching away from same*. Again, Nelson teaches away from use of the two stage drying method on surfaces which are not Class A, let alone the temporary protective films of Swidler which are never seen by the automobile purchaser, while the proposed modification is contrary to the simplicity which Swidler emphasizes in his process.

Relative to item 3), applicant respectfully submits that neither reference discloses or suggests a stabilizing step as defined in the present claims when this term is reasonably interpreted in accordance with the disclosure of the stabilizing step in the present specification, i.e., the disclosed stabilization step involves exposing the applied paint to a controlled atmosphere over a long period of time, prior to partial/preliminary drying step. In Swidler's process, once the strippable paint is applied to a vehicle, it is simply permitted to dry in a *single continuous operation* through exposure to ambient atmosphere over a period of time, such that there are not multiple separate steps of stabilizing, partially drying and finally drying, nor any special booths or controlled atmosphere associated therewith. Even in the one modification to his method disclosed by Swidler, i.e., addition of a larger percentage of alcohol as solvent when ambient temperatures are lower, the simple continuous drying operation is maintained. On the other hand, in Nelson's method, he indicates that his apparatus (IR lamps, and separate hot air blowers) may be used to set, dry and/or cure an applied coating depending on what treatment is desired, and he never discusses any stabilizing step between the application of a paint onto a surface and the treatment of same with his apparatus. Rather, Nelson indicates at his col. 13, lines 20-35 that a freshly painted object is directly treated using his apparatus. Thus, any hypothetical combination of the applied references would not achieve the claimed invention involving the stabilizing step.

Relative to the Examiner's comments on the declarations of Mr. Tojo and Mr. Kuroto, applicant respectfully traverses same because they are apparently based on a premise that

Swidler discloses or suggests the claimed method involving replacement of the conventional re-usable protective covers during a specific vehicle manufacturing step (assembling an engine and functional parts to the vehicle) with a strippable paint coating, whereas Swidler never discloses or suggests this feature. The claimed invention goes far beyond Swidler's disclosure. As such, the claimed method involving an application of the strippable paint is not contemplated by Swidler or any other prior art (as reflected by the continuing widespread use of re-usable protective covers during vehicle assembly processes), and the significant advantages achieved by the present invention are not "readily apparent to one skilled in the art" or the claimed method would have been common practice in the industry long ago (e.g., Swidler's application was filed 10 years ago).

Based on the foregoing, applicant respectfully submits that the rejection of claims 20, 26, 27, 30-33 and 37-42 under 35 USC §102(b) and/or §103(a) are overcome, and accordingly it is respectfully requested that the rejections be reconsidered and withdrawn.

Conclusion

Applicant has overcome the Examiner's objection and rejections set forth in the Office Action, and moreover, applicant respectfully submits that each of the present claims in the application are allowable over all the references of record, whether considered singly or in combination.

The application is now believed to be in condition for allowance, and a notice to this effect is earnestly solicited.

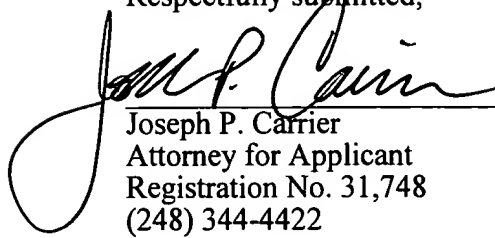
Finally, applicant again wishes to thank the examiner for the upcoming personal interview he has agreed to conduct with applicant's representative and one of the inventors in February 2003.

A Petition for Two Month Extension is being filed concurrently herewith.

Favorable consideration and entry of the present amendment are respectfully requested.

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December 2, 2002

Respectfully submitted,

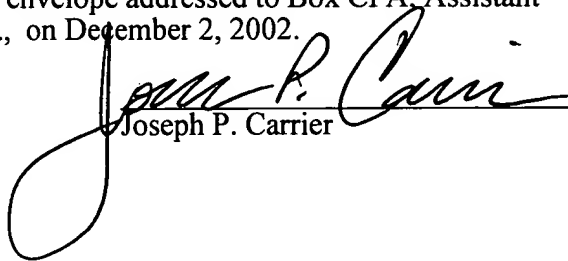


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the US Postal Service as Express Mail Certificate No. EV077537144US in an envelope addressed to Box CPA, Assistant Commissioner for Patents, Washington D.C., on December 2, 2002.

Dated: December 2, 2002
JPC/ms



Joseph P. Carrier

Paragraph Added Between Lines 2-3 On Page 1

The present application is a divisional application of co-pending application Serial No.

pl 08/398,881, filed March 6, 1995.

Marked-Up Copy of Amended Claims 40 and 43

40. (Amended) The method of claim 31, wherein said strippable paint is water soluble and said stabilizing step is performed at [a] an ambient temperature of 15 -30 °C and an ambient humidity of 50-80%.

43. (Amended) The method of claim 31, wherein said strippable paint is water soluble and said stabilizing step is performed by allowing the automobile to stand for a long time at an ambient temperature of 15 -30 °C and an ambient humidity of 50-80% after the application of the strippable paint before said preliminary drying step.